



051

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,261	02/17/2000	Dennis Palatov	MGANO-010A	7408

7590 01/04/2005

BRIAN M. BERLINER, Esq.
O'MELVENY & MYERS LLP
400 SOUTH HOPE STREET
LOS ANGELES, CA 90071-2899

EXAMINER

TRAN, HAI V

ART UNIT	PAPER NUMBER
----------	--------------

2611

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/506,261

Applicant(s)

PALATOV ET AL.

Examiner

Hai Tran

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 01 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 1-29, 31 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30, 32-34 and 36-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments, filed 07/01/2004, with respect to the rejection of claim 30 has been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 51 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term/limitation "nonstandard communication protocol" is vague and indefinite. It is unclear how the communication protocol or what type of communication protocol applicant refers to be nonstandard. It is unclear what the metes and bounds are of such a term. Furthermore, the specification does not describe the term in sufficient detail to enable such a determination.

Further clarification is required. The following art rejection is applied to applicant claims as best understood in view of the 112 2nd paragraph rejection above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 30, 32-34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (US 5909638) in view of Tatebayashi (US), and further in view of Abecassis (US 6192340), and further in view of Russo (US 5619247).

Regarding claim 30, Allen discloses a system for distributing video content (Fig. 1, Abstract), the system comprising:

An interactive kiosk configured to be located in a public location (fig. 16) (Col. 22, lines 15-40), the kiosk further configured to receive and access/read/write the data/video into a variety of content storage *device* (VHS videotape, recordable laser disk or DVD, etc..., see Col. 1, lines 25-32 and Col 5, lines 50-55). Moreover, Allen further suggests that the Kiosk able to read "tracking information" from the return of the content storage device's rental (Col. 8, lines 41-53).

Allen does not clearly disclose the kiosk further configures to securely store video content on the portable video content storage device upon which digitally encoded video content is securely stored to prevent unauthorized access; a set-top box configured to receive the portable video content storage device, to access/write the securely stored video content from the portable video content storage device and to provide the video content as an output signal to a video display.

Tatebayashi describes a method to securely store video content on the portable video content storage device upon which digitally encoded video content is

securely stored (using encryption method to store information/data on the portable device) and to prevent unauthorized access by using authentication protocol (Col. 5, lines 65-Col. 6, lines 11). Tatebayashi further discloses a set-top box (Fig., 2; elements 101 and Fig. 5, element 101 as a broadcast satellite receiver; see col. 10, lines 15-47) configures to receive the portable video content storage device to access the securely stored video content from the portable video content storage device and to provide the video content as an output signal to a video display (Once, the authentication protocol is verified, the access is authorized to perform any functions required to display necessary on any display device; i.e., TV, computer monitor). It is noted that "A portable video content storage devices" is defined as any portable apparatus that store data/video information and it could be carried by users; i.e., portable VCR/DVD/CD device, VHS tape, CD/DVD disk or cartridge medium, PCs, Laptop, PCMCIA card with integrated storage, etc... Fig., 2; elements 104, 105, 106, 102, 103 and Fig. 4, element 104). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Allen's system to securely configure the kiosk to securely store video content on the portable video content storage and to prevent unauthorized access to stored video content on the portable video content storage device, as taught by Tatebayashi, so to prevent the video productions/recording from being distributed to unauthorized devices (Col. 1, lines 47-50).

Allen does not clearly disclose wherein the Kiosk and the set-top box is configured to have the portable video content storage device as removable storage

device, i.e. removable hard disk, CompactFlash, Smartmedia... and Tatebayashi discloses a set-top box (Fig., 2; elements 101 and Fig. 5, element 101 as a broadcast satellite receiver; see col. 10, lines 15-47) configures to receive the portable video content storage device, i.e., DVD-RAM, connects to the set-top box, but not removable from within the set-top box .

Abecassis' 340 discloses a removable drive/compact portable storage could be implemented in a set-top box or any system (see Fig. 1, el. 104 and 105; Col. 6, lines 3-28). Therefore, it would have been obvious to an ordinary skill in the art at the time the invention was made to modify Allen and Tatebayashi with Abecassis' 340 so to provide to user to use a wide variety of removable device that are available on the market in which the user could plug and play the removable device to any system, i.e., set-top box, Kiosk ...that user would like to write/read data between the removable device and the system connected.

Allen, Tatebayashi and Abecassis'340 do not clearly disclose wherein the set-top box is configured to write content use data to the portable video content storage device and the kiosk configures to read content use data from the portable video content storage; however, as discussed above, Allen discloses the kiosk able to read "tracking information" from the return of the content storage device's rental (Col. 8, lines 41-53).

Russo discloses a set-top box control access to a secured data content of a storage medium 110 and is configured to write content use data to the storage medium 110 (Col. 10, lines 10-65+). Therefore, it would have been obvious to one

of ordinary skill in the art at the time the invention was made to modify Allen, Tatebayashi and Abecassis' 340 with Russo to accumulate and write content use data, as suggested by Russo, to the removable-portable storage device so to keep track the usage of users for billing purposes (Col. 3, lines 15-30). Furthermore, in view of all the teaching of Allen, Tatebayashi and Abecassis' 340 with Russo, it would have been obvious that Allen 's kiosk would be able to read content use data (tracking information) from the return of the content storage device's rental so the billing process at the kiosk able to give back credit or reduce charge to user for the percentage of the video content that has not been viewed by the user as suggested by Russo (Col. 5, lines 35-65).

Regarding claim 32, Tatebayashi further discloses wherein the portable video content storage device consists essentially of passive storage media unit (Col. 8, lines 5-15).

Regarding claim 33, both Tatebayashi (Col. 5, lines 65-Col. 6, lines 11) and Russo (Fig. 2, el. 114; Col. 7, lines 55-61 and Col. 10, lines 10-23) disclose encoded video content stored on the storage medium is encrypted to prevent unauthorized access.

Regarding claims 34 and 36, the method of claims 34 and 36 is analyzed with respect to apparatus claim 30.

2. Claims 37- 43 and 45 rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (US 5909638) in view of Tatebayashi (US), and further in view of Abecassis

(US 6192340), and further in view of Russo (US 5619247), and further in view of Cantone (US 5734781).

Regarding claim 37, the hand-held dedicated secure video content storage device is analyzed with respect to claim 30. The communication port mounted in the housing of Tatebayashi's devices (Fig. 1, 2; elements 104, 105, 106, 102, 103) is obvious to be removable configured to connect/disconnect to the Kiosk.

Furthermore, removable drive suggested by Abecassis' 340 must also have communication port mounted in the housing of the removable drive. Russo further discloses a controller configured to prevent unauthorized access to the mass storage module, the controller further configured to permit video content to be written to the mass storage module.

Abecassis' 340 does not clearly disclose removable drive housing suggested containing a controller.

Cantone discloses a removable drive housing containing a controller (Fig. 1, el. 22). Therefore, it would have been obvious to an ordinary skill in the art at the time the invention was made to modify Allen, Tatebayashi, Abecassis' 340 and Russo with Cantone to have a controller built-in the removable drive housing so to control all the functions pertaining to that device such as to protect/ prevent authorized access to the removable-portable (handheld) storage device in case of lost or misplaced.

Regarding claim 38, Tatebayashi's devices (Fig. 1, 2; elements 104, 105, 106, 102, 103) further discloses wherein the communication port comprises an

electrical connector (fig., element 107). Furthermore, removable drive suggested by Abecassis' 340 must also have "the communication port comprises an electrical connector" .

Regarding claim 39, Tatebayashi fails to show the communication port comprise an optical connector.

Official Notice is taken that the use of an optical connector is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tatebayashi by including an optical connector so to provide a more choice of connectivity between devices.

Regarding claims 40, Tatebayashi further discloses an authentication scheme to communicate with only devices that have a reference authentication table pre-configured (Col. 5, lines 65-Col. 6, lines 60).

Regarding claim 41, see analysis of claim 30 in combination with claim 40.

Regarding claim 42, Tatebayashi's devices (Fig. 1, 2; elements 104, 105, 106, 102, 103) all have a disk drive.

Regarding claim 43, with the teaching of Tatebayashi ' authentication protocols (Col. 8, lines 15-65+), Tatebayashi clearly encompass the claimed limitation "configured to separately limit read and write access to the disk drive".

Regarding claim 45, see analysis of claim 30.

3. Claims 44, and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (US 5909638) in view of Tatebayashi (US), and further in view of

Art Unit: 2611

Abecassis (US 6192340), and further in view of Russo (US 5619247), and further in view of Cantone (US 5734781), and further in view of Abecassis (US 5696869).

Regarding claim 44, Allen, Tatebayashi, Abecassis ' 340, Russo and Cantone do not disclose wherein the controller comprises a data buffer configured to buffer data as the data is transferred to or from the disk drive.

Abecassis' 869 discloses wherein the controller comprises a data buffer configured to buffer data as the data is transferred to or from the disk drive (Col.10, lines 33-60). Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Allen, Tatebayashi, Abecassis ' 340, Russo and Cantone to have a data buffer configured to buffer data as the data is transferred to or from the disk drive, as taught by Abecassis' 869, so to retrieve subsequent from information from the video disk without altering the transmission of the required frames per second to provide a transparently continuous video signal transmission, as suggested by Abecassis' 869 (Col. 10, lines 35-40).

Regarding claims 46 and 47, Allen, Tatebayashi, Abecassis ' 340, Russo and Cantone do not clearly disclose wherein the controller is configured to limit access to the mass storage module based at least upon a content rating of a content unit and a set of user preference relating to the format content units to be stored on the mass storage module.

Abecassis' 869 discloses the controller is configured to limit access to the mass storage module based at least upon a content rating of a content unit (Col. 10,

Art Unit: 2611

lines 50- Col. 11, lines 15) and a set of user preference relating to the format content units to be stored on the mass storage module (Col. 11, lines 15-23).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Allen, Tatebayashi, Abecassis ' 340, Russo and Cantone so to limit access to the mass storage module based at least upon a content rating of a content unit so to provide a video program that is highly responsive to viewer control over its content (see col. 5, lines 5-12).

4. Claims 48-51, 53, and 57-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis (US 6192340) in view of Russo (US 5619247).

Regarding claim 48, Abecassis' 340 discloses a set-top box for accessing video content stored on a portable video content storage device, the set-top box comprising:

A receptacle configured to receive the portable video content storage device, wherein the portable video content storage device can be inserted and removed by a user (Fig. 1, el. 104; Col. 6, lines 2-46);

A video decoder module configured to decode the video content to produce an output signal; and a processor configured to control the video decoder module (Col. 7, lines 15-42)

Abecassis' 340 does not clearly disclose a processor configured to accumulate present content use data based at least upon an amount use of the

video content and to store the accumulated content use data onto the portable video content on the portable video content storage device.

Russo discloses a set-top box control access to a secured data content of a storage medium 110 and is configured to write content use data to the storage medium 110 (Col. 10, lines 10-65+). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Abecassis' 340 with Russo to accumulate and write content use data, as suggested by Russo, to the removable-portable storage device so to keep track the usage of users for billing purposes (Col. 3, lines 15-30).

Regarding claim 49, Abecassis' 340 further discloses wherein the processor is further configured to control the portable video content storage device (Col. 7, lines 15-55).

Regarding claim 50, Russo further discloses a decryption module (Fig. 1, element "Descramble".)

Regarding claim 51, Abecassis' 340 further discloses a translation module configured to translate a non-standard communication protocol used by the portable video content storage device (i.e., removable subsystem 104 or compact memory subsystem 105) into an industry standard communications protocol (Col. 6, lines 3-38; Col. 8, lines 9-65+).

Regarding claim 53, Abecassis' 340 further discloses wherein the output signal comprises video information and audio information (see Fig. 4).

Regarding claims 57 -59, the method claims 57 – 59 are analyzed with respect to claim 48.

Regarding claim 60, Russo further discloses the content use data comprises a listing of executed user commands (Col. 9, lines 38- col. 10, lines 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Abecassis' 340 to incorporate a listing of executed user commands along with the content use data, as taught by Russo, so to enhance the tracking of the usage/access of the content by triggering of account debit at different points in time associated with the selection of the desired program (Col. 10, lines 15-20).

Regarding claim 61, Russo further discloses the content use data associates a number of uses with a portion of the video content (Col. 10, lines 10-22).

5. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis (US 6192340) in view of Russo (US 5619247), and further in view of Tatebayashi et al. (US 6182215 B1).

Regarding claim 52, Abecassis and Russo do not clearly disclose the STB further comprising an authentication module configured to provide authentication information to the portable video content storage device.

Tatebayashi discloses an STB's authentication module configured to provide authentication information to the portable video content storage device (Fig. 5; elements 101 and Fig., 2; elements 104, 105, 106, 102, 103). Therefore, it would

Art Unit: 2611

have been obvious to one of ordinary skill in the art at the time the invention was made to modify Abecassis and Russo to securely configure the authentication of the portable video content storage, as taught by Tatebayashi, so to prevent the video productions/recording from being distributed to unauthorized devices (Col. 1, lines 47-50).

6. Claims 54 -56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis (US 6192340), and further in view of Russo (US 5619247) and further in view of Abecassis (US 5696869).

Regarding claims 54-56, Abecassis' 340 and Russo do not disclose wherein the processor is further configured to access user preferences stored on the portable video content storage device based at least upon a content rating of the content unit and to modify the user references.

Abecassis' 869 discloses the processor of a Video disk player is further configured to access user preferences stored on the portable video content storage device based at least upon a content rating of the content unit and to modify the user references, (Col. 9, lines 53-Col. 10, lines 32; Col. 10, lines 50- col. 11, lines 15; Col. 11, lines 15-23).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Abecassis' 340 and Russo to configured to access user preferences stored on the portable video content storage device based at least upon a content rating of the content unit and to modify the user references, so to

provide a video program that is highly responsive to viewer control over its content (see col. 5, lines 5-12).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is 703-308-7372. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C. Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HT:ht
12/22/2004

A handwritten signature in black ink, appearing to read 'Hai Tran', is written over two horizontal lines.

**HAITRAN
PRIMARY EXAMINER**